

JUL 19 2006

SMART & BIGGAR

Intellectual Property & Technology Law

To Fax no.: 1 571 273 8300
Page 1 of: 10
Attention: APPEAL BRIEFS
Reply Brief for Examiner Joseph E.
AVELLINO
From: Matthew Zischka
Your file no.: 09/825,412
Reply to Toronto file no.: 92027-5
Date: July 19, 2006
Time:
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Please see the following attached documents:

1. Transmittal Form (1 page);
2. Fee Transmittal (1 page); and
3. Appellant's Reply Brief under 37 C.F.R. 1.193(b) (7 pages).

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PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

9

Application Number 09/825,412

Filing Date April 3, 2001

First Named Inventor Grant HOOP

Art Unit 2143

Examiner Name Joseph E. AVELLINO

Attorney Docket Number 82027-5

ENCLOSURES (Check all that apply)☒ Fee Transmittal Form☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/Incomplete Application☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation☐ Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD. Number of CD(s) _____☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board of Appeals and Interferences☒ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☐ Other Enclosure(s) (please identify below):

Remarks

Reply Brief under 37 C.F.R. 1.193(b)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name SMART & BIGGAR

Signature

Printed name Matthew Zischka

Date July 19, 2006

Reg. No. 41,575

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name Matthew Zischka

Date July 19, 2006

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FEE TRANSMITTAL
For FY 2006☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

Application Number	09/B25,412
Filing Date	April 3, 2001
First Named Inventor	Grant HOOD
Examiner Name	2143
Art Unit	Joseph E. AVELLINO
Attorney Docket No.	92027-5

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☒ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 19-2548 Deposit Account Name: _____

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

SUBMITTED BY

Signature

Registration No. 41,675
(Attorney/Agent)

Telephone (416) 593-5514

Name (Print/Type) Matthew Zischka

Date July 19, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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T-578 P.004/010 F-493

JUL 19 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS

In re the application of:

Grant HOOD et al.

Application No:09/825,412

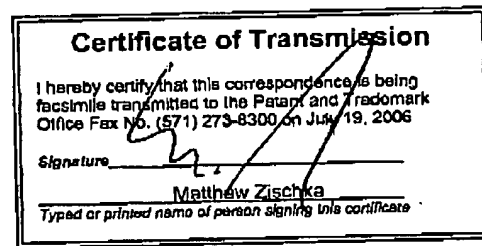
Filed: April 3, 2001

For: Methods and Devices
For Providing Pooled
Personal Introduction
Services

Group Art Unit: 2143

Examiner: Joseph E. AVELLINO

Attorney Docket: 92027-5



APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 1.193(b)

The Assistant Commissioner of Patents
Washington, D.C. 22313
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Reply Brief, submitted under the provisions of 37 C.F.R. 1.193.

This Reply Brief is responsive to the Examiner's Answer, mailed May 19, 2006 (hereinafter "Examiner's Answer"). However, in this Reply Brief the Applicant does not intend to address all of the claims pending in the application nor all of the issues raised by the Examiner in the Examiner's Answer. The Applicant reasserts all submissions made in the Appeal Brief. Submissions presented in this Reply Brief are presented to further clarify the Applicant's position and are in no way intended to detract from arguments previously made by the Applicant.

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As previously set out in the Appellant's Appeal Brief, the Examiner has rejected independent claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of US Patent Publication 2002/0073343 to "Ziskind" et al. (hereinafter "Ziskind") and US Patent No. 6,665,3879 to "Haste" (hereinafter "Haste").

Claims 1-20 claim systems and methods of facilitating exchange of messages at a computerized message exchange system (e.g. computerized dating systems). A first and second plurality of greetings are stored at the system. Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider.

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.

The primary reference applied by the Examiner, Ziskind, has little to do with the present invention. It is directed to a system allowing exchange of instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying purpose of instant messaging, and is in principal no different

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than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and the remaining references were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor the remaining references disclose all elements of independent claims 1, 12 or 17.

As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings, and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service provider include the gender, age and interest of users of the second service provider.

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In response to this argument, the Examiner's continues to misread the claims and Ziskind. The Examiner asserts at page 10 in his Examiner's Answer

"As to point (2), the Examiner agrees with the recitation of cited passages by the Appellant, however, disagrees that the combination does not disclose figin access to selected users by the first service provider. As evidenced by the cited passges by the Appellant (specifically p.3 ¶ 32 of Ziskind) a user directory allowing the user the ability to determine whether or not the user should be visible by others (i.e. notify others that user X has signed on). This way, user Y cannot view user X's information without the permission of X. In this fashion, the system gives access to user Y only those users which request to be displayed in the user directory. Utilizing the greetings of the Internet dating system of Haste, results in multiple affiliated dating and introduction services pooling together resources in order to get a wide variety of messengers to communicate with one another."

To illustrate the deficiency in this reasoning, the following attempts to map the FIRST USER/SECOND USER language of the claims to the Examiner's reasoning:

As evidenced by the cited passges by the Appellant (specifically p.3 ¶ 32 of Ziskind) a user directory allowing the user [SECOND USER] the ability to determine whether or not the user [SECOND USER] should be visible by others (i.e. notify others that user X [SECOND USER] has signed on). This way, user Y [FIRST USER] cannot view user X's [SECOND USER] information without the permission of X [SECOND USER].

This reasoning, however, is not consistent with the claim language. As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second

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greetings, and criteria set by the first service provider, and not the second user (i.e. not "the permission of X, argued by the Examiner"). Not surprisingly, in the instant Internet messaging system of Ziskind, it is user X that decides whether or not he/she should be viewable by user Y. As claimed, it is the second user [user X] and the first user's service provider [the service provider for user Y] that set criteria used to decide.

In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service provider include the gender, age and interest of users of the second service provider.

To establish a *prima facie* case of obviousness under 35 USC 103., all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. All claim elements have not been found in the art. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the invention. As such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight.

For all of these reasons, and those contained in the Appellant's Brief, it is submitted that the Examiner has failed to establish a *prima facie* case of obviousness. Reversal of the Examiner's rejections under 35 USC 103 is therefore respectfully requested.

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In response to the Examiner's formalities objection to the Summary of Invention in the Appeal Brief, a revised Summary of Invention is attached, as Appendix "A" hereto.

Respectfully submitted,

By 

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Date: July 19, 2006
92027-5
MZ/kdr
Enclosure

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Appendix "A"

Summary of the Invention

The invention relates to a method of facilitating exchange of messages at a computerized message exchange system (e.g. p. 5, line 6 – p. 6; FIG. 1 – 10). A first and second plurality of greetings are stored at the system (FIG. 1 – 34). Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. (e.g. p. 11, line 12 – p.12, line33, FIG. 3A) Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider. (e.g. pp. 21, line 20 – p. 23, line 26; FIG. 5 – steps S512, S514).

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.